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**TRANSMITTAL
FORM**

(To be used for all correspondence after initial filing)

Application Number	08/976,820
Filing Date	November 25, 1997
First Named Inventor	JORN LEIBER ET AL.
Group Art Unit	1771
Examiner Name	J. Guarriello
Attorney Docket Number	tesa AG 481-KGB

Total Number of Pages in This Submission

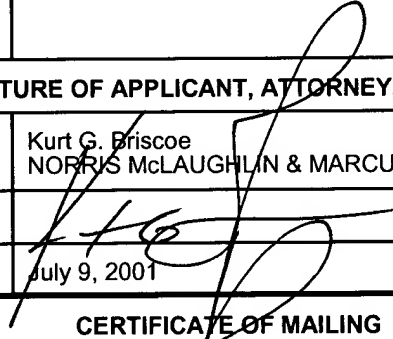
ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Response <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip(PTO/SB/69) and Accompanying Petition <input type="checkbox"/> To convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below): <p>Notice of Change of Firm Address</p>
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Remarks:

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 TC 1700

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Kurt G. Briscoe NORRIS McLAUGHLIN & MARCUS, P.A.
Signature	 Reg. No. 33,141
Date	July 9, 2001

CERTIFICATE OF MAILING

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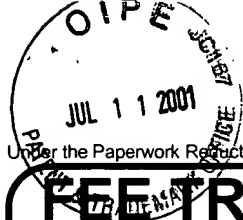
Typed or printed name	Kurt G. Briscoe
Signature	
Date	7/9/01

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1771

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FEE TRANSMITTAL for FY 2001

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT

\$700.00

Complete if Known

Application Number	08/976,820
Filing Date	November 25, 1997
First Named Inventor	JORN LEIBER et al.
Examiner Name	J. Guarriello
Group Art Unit	1771
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METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit
Account
Number

14-1263

Deposit
Account
Name

Norris, McLaughlin & Marcus

- ☒ Charge Any Additional Fee Required
Under 37 CFR §§ 1.16 and 1.17

- ☐ Applicant claims small entity status.
See 37 CFR § 1.27

2. ☐ Payment Enclosed:

☐ Check ☐ Credit card ☐ Money
Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Small Entity Fee Code	Fee (\$)	Fee (\$)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	
SUBTOTAL (1)					\$0.00

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
	-20** = 0	X 18.00 =	0.00
Independent Claims	-3** = 0	X 0.00 =	0.00
Multiple Dependent			

Large Entity Fee Code	Small Entity Fee Code	Fee (\$)	Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	80	209	40	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) \$0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Small Entity Fee Code	Fee (\$)	Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non - English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	390.00
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	310.00
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR § 1.17(q)	
126	180	126	180	Submission of Information Disclosure Statement	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	800	169	900	Request for expedited examination of a design application	
Other fee (specify)					

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) \$700.00

SUBMITTED BY

Name (Print/Type)	KURT G. BRISCOE	Registration No. (Attorney/Agent)	33,141	Telephone	212-808-0700
Signature		Date	July 9, 2001		

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tesa AG 481-KGB
00467

**EXPEDITED EXAMINING PROCEDURE
AMENDMENT AFTER FINAL REJECTION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : JORN LEIBER ET AL.
SERIAL NO. : 08/976,820
FILED : November 25, 1997
FOR : USE OF AN ADHESIVE TAPE SECTION
ART UNIT : 1771
EXAMINER : J. Guarriello

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AMENDMENT UNDER 37 CFR § 1.116

SIR:

In response to the Office Action dated February 9, 2001, please enter the following:

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time,

Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

At the outset, Applicants wish to address the showing required under 37 CFR § 1.116(a) regarding why this amendment is necessary and was not presented earlier. This amendment is responsive to new points made for the first time in the final rejection. Since this is the first substantive response to the final rejection, this amendment could not have been presented earlier. In view of the foregoing, Applicants respectfully request that the Examiner enter and consider this amendment.

The sole issue for consideration is the rejection of claims 20-33 under 35 USC § 103(a) as being obvious over Luhmann et al. ("Luhmann"), U.S. Patent No. 5,725,923, in view of Cole, U.S. Patent No. 5,622,761. In response, Applicants again submit that the combination of references does not make out a *prima facie* case of obviousness against the present claims.

Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner says at the bottom of page 3 of the final rejection that the prior art need not expressly teach the changes Applicants have made and the test for obviousness is what the references as a whole would have suggested to persons skilled in the art. Applicants accept this statement of the law, but submit that using this test the cited combination of references clearly fails to establish *prima facie* obviousness.

As stated in *In re Shaffer*, 108 USPQ 326, 328-329 (CCPA 1956):

“It is too well settled for citation that references may be combined for the purpose of showing that a claim is unpatentable. However, they may not be combined indiscriminately, and to determine whether the combination of references is proper, the following criterion is often used: namely, whether the prior art suggests doing what an applicant has done. * * * [I]t is not enough for a valid rejection to view the prior art in retrospect once an applicant’s disclosure is known. *The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done.* [Emphasis added.]”

Main claim 20 expressly provides that the adhesive tape section is designed “as a polygon

having a number of sides *and the same number of grip tabs.*” Main claim 27 expressly provides that the adhesive tape section is designed “as a circle” with “the adhesive region occupying a central portion of said circle, said grip tab occupying an outer portion of said circle, and said grip tab surrounding said adhesive region.”

Applicants submit that the cited combination of references cannot be said fairly to suggest these structural features of the instant claims. There is no suggestion—express or implied—in the cited combination of references to provide a number of grip tabs equal to the sides of the polygon-shaped adhesive or a surrounding grip tab in the case of a circle-shaped adhesive. While Applicants believe that Cole relates to a different adhesive technology, and is not properly combined with Luhmann, the fact that Cole describes various shapes for the adhesive provides no teaching or suggestion as to the number of grip tabs or their shape. Since Luhmann at best describes *two* grip tabs for a rectangular adhesive tape (which is a four-sided polygon, and, according to the present invention, should have *four* grip tabs), Luhmann not only fails to teach or suggest the present number of grip tabs or their shape, but, by teaching less than the number expressly required by the instant claims, actually teaches away from the present invention. Accordingly, it should be clear that the combination of Luhmann and Cole likewise fails to teach or suggest the present number of grip tabs or their shape. Since the present claims expressly require a specific number of grip tabs or their shape, and this feature of the claims is not taught nor suggested by the combination of Luhmann and Cole, the combination of Luhmann and Cole

could not have rendered the present claims *prima facie* obvious to persons skilled in the art at the time the present invention was made.

The situation regarding the number of grip tabs and their shape is summarized in the following table:

Table

SHAPE	GRIP TABS (LUHMANN)	GRIP TABS (INVENTION)
Triangular	Silent	3
Rectangular	2	4
Pentangular	Silent	5
Hexangular	Silent	6
Circular	Silent	Circular

It should be clear that Luhmann does not teach or suggest the number of grip tabs or their shape as is required by the present claims. Cole does not remedy this deficiency as Cole does not teach or suggest grip tabs at all! Consequently, the combination of Luhmann and Cole cannot teach or suggest the number of grip tabs or their shape as required by the instant claims.

At the top of page 3 of the final rejection, the Examiner concedes to Applicants' previous argument that Luhmann teaches grip tabs as being optional, but finds that this does not exclude

tabs to be used to one of ordinary skill in the art. However, the fact that Luhmann teaches that grip tabs are optional is very important as it reveals a lack of motivation to provide Luhmann's adhesives with the two grip tabs expressly taught by Luhmann let alone to modify them to the four grip tabs that would be required by the present claims for a rectangular tape like Luhmann's. By teaching the grip tabs are optional, and not necessary, Luhmann teaches away from their use, and also away from the use of an even greater number of grip tabs as required by the instant claims.

Applicants submit that the cited combination of references does not fairly suggest to persons skilled in the art the structural features of the claims as discussed above. Accordingly, for this reason alone, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection altogether.

Applicants also emphasize that method claims 31-33 stand on a separate footing than the other claims. Luhmann expressly teaches at column 2, lines 27-30, that the adhesive bond is broken by "pulling the object," i.e., *the substrate*, in the direction of the bond plane. Thus, this is completely different from what is required in claims 31-33, namely pulling on at least one of the grip tabs of *the adhesive tape itself* in the direction of the bond plane. While Applicants do not believe that the combination of Luhmann and Cole fairly suggests any of the limitations of any of the present claims, Applicants submit that the combination of Luhmann and Cole certainly does

not suggest the limitations of claims 31-33. Accordingly, even if the rejection is maintained against claims 20-30, claims 31-33 should be allowed.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

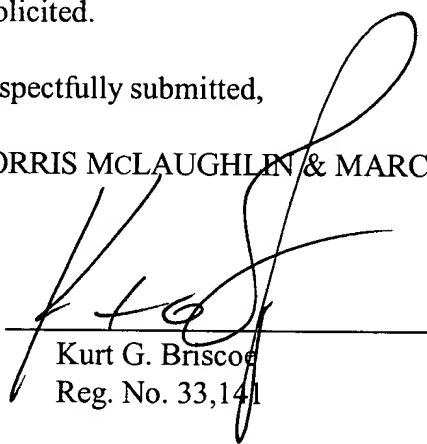
Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By



Kurt G. Briscoe
Reg. No. 33,141

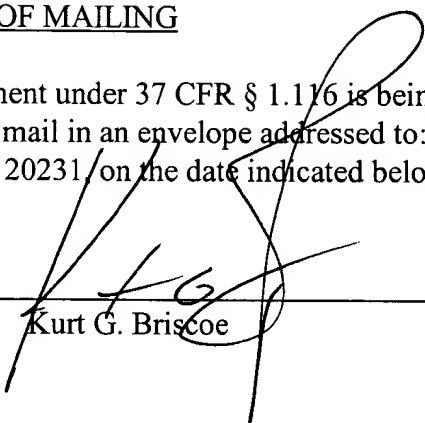
220 East 42nd Street
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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box AF, Hon. Commissioner of Patents, Washington, D.C. 20231 on the date indicated below:

Date: July 9, 2001

By


Kurt G. Briscoe